

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

**Enno KLUSSMAN et al.**

Examiner: SWOPE, Sheridan PhD

Serial No.: 10/526,768

Group Art Unit: 1652

Filed: NOVEMBER 7, 2005

Confirmation No.: 6937

Title: **AKAP18 DELTA, A NOVEL SPLICING VARIANT OF A PROTEIN KINASE A ANCHOR PROTEIN AND THE USE OF THE SAME**

**PETITION TO THE DIRECTOR UNDER 37 CFR §1.181**

Mail Stop : PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**Action Requested**

The Office Action of March 12, 2009 was improperly made final. Withdrawal of the finality of the Office Action is respectfully requested.

**Facts**

On December 30, 2008 Applicants filed a Reply with a Request for Continued Examination (RCE) to the Final Office Action of July 30, 2008. Thereafter, on February 3, 2009, the Examiner made a telephonic inquiry along with a proposed amendment of the claims. Applicants' representatives scheduled a telephonic interview with the Examiner on March 5, 2009. As per the Examiner's request, Applicants' representative emailed an "informal submission" to the Examiner, outlining the claim amendments, on March 3, 2009. See the enclosed Exhibit A. However, an agreement with the Examiner could not be reached. See, the Examiner's Interview Summary and page 2 of the outstanding Office Action.

On March 12, 2009, the Examiner mailed a Final Office Action. This is a first Office Action on the merits following Applicants' submission with the RCE filed December 30, 2008. As is evident from the Reply filed December 30, 2008, the instant claims were amended to delete a functional activity from broader claim 1 and claim 21 was amended to recite a biochemical aspect of the polypeptides encoded by the claimed AKAP $\delta$  polynucleotides (i.e., binding to PKA regulatory subunit II). See, the subject matter of claims 1 and 21. The Examiner re-evaluated the

§112, ¶1 rejections in light of Applicants' amendment of the claims. See, page 5 of the Office Action mailed March 12, 2009.

Applicants submit that the finality of the Office Action mailed March 12, 2009 is improper. As expressly stated under MPEP § 706.07(b):

The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, **and** (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114 (emphasis added).

With respect to (A), it is clear that *not all claims* are directed to the same invention claimed prior to entry of the RCE submission of December 30, 2008. Moreover, the Office Action has not establish that the claims would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered. Accordingly, the finality of the Office Action is improper, and should be withdrawn.

Additionally, in accordance with MPEP § 706.07(b), Applicants urge the Examiner to use form paragraph ¶ 7.41 for First Action, Final Rejections.

No fees are believed to be due with this paper; however, the Commissioner is hereby authorized to charge any fees associated with this response to Deposit Account No. 13-3402.

Respectfully submitted,

/Sagun KC/

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For Applicant(s)

/Anthony J. Zelano/

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Attorney Docket No.: HERTIN-0001

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